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Mailed: 9-8-06
In re application of :
Yoshizumi et al. :
Serial No. 10/050,866 : DECISION ON
Filed: January 18, 2002 : PETITION
For: ONBOARD FUEL CELL SYSTEM BAND :
METHOD OF DISCHARGING HYDROGEN- :
OFF GAS :

This is a decision on the PETITION UNDER 37 CFR 1.181 TO DIRECT THE EXAMINER TO EXAMINE WITHDRAWN CLAIMS 11 AND 12, dated June 27, 2006.

On September 7, 2005, the Examiner made a Restriction/Election requirement. The requirement included an election of species between embodiment 1, figure 1; embodiment 2, figure 6; and embodiment 3, figure 7. The election of species requirement as set forth by the Examiner required Applicant to fully elect one species and list the corresponding claims to the elected species. Applicant responded to the requirement in a response filed on October 14, 2005. In the response, Applicant elected the Species of embodiment 2, figure 6 and indicated that claims 1, 6, 8, 11-15, 21, 31, 37-39 read on the elected species. A second requirement was mailed on December 13, 2005 indicating that claims 11, 12 and 21 do not read on the elected species and should be considered withdrawn. Applicant responded on January 12, 2006 arguing that the claim limitations of claims 11, 12 and 21 do in fact read on the elected species. A third requirement was mailed on February 21, 2006 indicating that claim 21 reads on the elected species, but that claims 11 and 12 still do not read on the elected species. On March 6, 2006 the third requirement was vacated and a Non-Final Office Action on the merits was mailed on May 2, 2006 indicating claims 2-4, 9-12, 16-20, 22, 23, 32-36, 40-42, 44-49 were withdrawn as being directed to the non-elected species. Applicants responded to the Office Action on June 27, 2006 with arguments directed to the Examiner's holding of claims 11 and 12 as being directed to the non-elected species. A Final Office Action was mailed on August 4, 2006 continuing to indicate that claims 11 and 12 were withdrawn as being directed to a non-elected species.

On June 27, 2006 the instant petition under 37 CFR 1.181 was filed to formally request that the Examiner be directed to examine claims 11 and 12 as reading on the elected Species.

DECISION

Section 806.04(e) of the MPEP states:

806.04(e) [R-3] Claims Limited to Species

Claims are definitions of inventions. Claims are never species. The scope of a claim may be limited to a single disclosed embodiment (i.e., a single species, and thus be

designated a specific species claim), or a claim may include two or more of the disclosed embodiments within the breadth and scope of the claim (and thus be designated a generic or genus claim).

Species are always the specifically different embodiments.

Species may be either independent or related as disclosed (see MPEP § 806.04 and § 806.04(b)).

Section 806.04(f) of the MPEP states:

806.04(f) [R-3] Restriction Between Mutually Exclusive Species

Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. This may also be expressed by saying that to require restriction between claims limited to species, the claims must not overlap in scope.

Petitioner argues that the Examiner's holding of claims 11 and 12 as being withdrawn from consideration was incorrect in that claims 11 and 12 read on the elected embodiment of Figure 6.

Claim 11 recites:

The onboard fuel cell system according to claim 1, further comprising,

a seventh flow passage which leads to an oxidative gas-supplying port of the fuel cell and through which the supplied oxidative gas can flow;
a flow rate-changing portion which is disposed in the second flow passage or the seventh flow passage and which can change the flow rate of the discharged oxygen-off gas; and
a control portion adapted to control the valve and the flow rate-changing portion,
wherein the control portion can increase the flow rate of the discharged oxygen-off gas from a predetermined flow rate by means of the flow rate-changing portion when opening the valve.

Claim 12 recites:

The onboard fuel cell system according to claim 1, further comprising,

a seventh flow passage which leads to an oxidative gas-supplying port of the fuel cell and through which the supplied oxidative gas can flow;
a flow rate-changing portion which is disposed in the second flow passage or the seventh flow passage and which can change the flow rate of the discharged oxygen-off gas; and
a control portion which controls the valve and the flow rate-changing portion,
wherein the control portion opens the valve by means of the flow rate-changing portion if the flow rate of the discharged oxygen-off gas is higher than a predetermined flow rate.

The limitation in question is that there is a "flow rate-changing portion which is disposed in the second flow passage or the seventh flow passage and which can change the flow rate of the discharged oxygen-off gas". The elected species of embodiment 2, figure 6, includes a flow rate-changing portion which is disposed in the seventh flow passage and which can change the flow rate of the discharged oxygen-off gas which is represented by the compressor 504. However, the

limitation that there is a flow rate-changing portion which is disposed in the second flow passage and which can change the flow rate of the discharged oxygen-off gas does not read on the elected species in that no flow rate-changing portion in the second flow passage was described in the second embodiment, figure 6. Thus, the claims recite limitations that read on both the elected species and non-elected species stated in the alternative form. Therefore, the alternative which includes the claim limitation of providing a flow rate-changing portion in the seventh flow passage is considered to read on the elected species and should be examined with the other elected claims.

Accordingly, because the withdrawing of claims 11 and 12 as being directed to a non-elected species was improper, the petition is **GRANTED**. The Examiner is directed to send out an Office Action considering the claims 11 and 12 for examination.



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